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REMARKS

As a preliminary matter, it is noted that the Examiner has crossed out one of the references (non-patent publication to Satoshi Iino) listed in the PTO-1449 form filed on September 8, 2004, without any explanation as to why that reference was not considered. As evidenced by the attached stamped post-card, each of the 10 references listed in the PTO-1449 form was submitted and received by the USPTO. It is respectfully requested that the Examiner provide Applicants another initialed copy of the PTO-1449 form indicating that *each* of the prior art references, including Satoshi Iino, have been considered and made of record.

In addition, it is noted that the Examiner relied on Kuwabata et al. (2001) in the § 103 rejection; however, it does not appear to have been made formally of record. Accordingly, in the next Office Action, it is respectfully requested that the Examiner list Kuwabata et al. (2001) in a PTO-892 form to make the record clear that it was considered by the Examiner.

Claims 5 and 11 are objected to for minor informalities. It is respectfully submitted that the enclosed amendment obviates the alleged informalities. Accordingly, it is respectfully requested that this objection be withdrawn.

Claims 1, 5, 6 and 11 stand rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed for the following reasons. Claim 1 has been amended, simply as a rewording, to obviate the alleged definiteness.

Regarding claims 5 and 6, the Examiner alleges that "it is exceedingly difficult to ascertain what exactly is being claimed, especially for one not skilled in the art of

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“electrochemistry” (emphasis added). However, the Examiner does not point to any specific alleged indefiniteness but merely concludes *generally* that the claims are unclear. Indeed, the Examiner’s qualification that the claims would be unclear to “one not skilled in the art of electrochemistry” is not pertinent to satisfying the requirements under § 112, second paragraph.

Instead, as set forth in MPEP § 2171, a § 112, second paragraph “requirement is an objective one because it is *not dependent on the views of applicant or any particular individual* [(e.g., an examiner)], but is evaluated in the context of whether the claim is definite - i.e., whether the scope of the claim is clear *to a hypothetical person possessing the ordinary level of skill in the pertinent art*” (emphasis added). In the instant case, it is respectfully submitted that one of ordinary skill in the electrochemistry art would readily understand the metes and bounds of claim 5, and the Examiner has not provided any explanation as to which portion(s) of claim 5 would allegedly not be understood.

In any event, claims 5 and 6 have been amended, simply as a rewording, so as to obviate the Examiner’s alleged indefiniteness. With regard to the rejection of claim 11, the Examiner is silent, and it appears that the alleged indefiniteness is based on the misspelling referenced in the objection to claim 11, which has been addressed by the enclosed amendment.

Based on all the foregoing, it is respectfully submitted that claims 1, 5, 6 and 11 are definite. Accordingly, it is respectfully requested that this rejection be withdrawn.

Claim 1 is the sole independent claim and stands rejected under 35 U.S.C. § 102 as being anticipated by Ikeda et al.. This rejection is respectfully traversed for the following reasons.

The Examiner admits that Ikeda et al. is silent as to the type of current that will be supplied to the working electrode, but apparently alleges that Ikeda et al. inherently discloses

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applying an AC potential. The Examiner basis for alleging so is because Ikeda et al. allegedly discloses that "both positive and negative voltages are used in the working examples."

As a preliminary matter, it is respectfully submitted that the Examiner's premise is incorrect. Claim 1 recites in pertinent part, "applying an AC potential *to said working electrode*...." Ikeda et al., contrary to the Examiner's allegation, discloses only a positive voltage being applied to the working electrode. The negative voltage of Ikeda et al. appears to be directed only to the third electrode disclosed therein (*see col. 11, lines 13-18*). Accordingly, the working electrode of Ikeda et al. does not appear to have both polarities applied thereto as relied on by the Examiner.

Moreover, the disclosed voltages in Ikeda et al. would more likely be DC as opposed to AC, as described in the background section of Applicants' specification. This is because Ikeda et al.'s description of a negative voltage (i.e., -1300mV) appears to imply DC, as AC would not appear to be described with a polarity.

Further, given that a stated voltage can be either DC or AC and because the disclosed voltages (500 and -1300) of Ikeda et al. are obviously not applied simultaneously to the same electrode, it certainly is NOT inherent that the Ikeda et al.'s voltages are necessarily AC as would be required to make the Examiner's inherency argument. As is well known in patent prosecution, "inherency may not be established by probabilities or possibilities," *see Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999).

In sum, the Examiner's allegation that Ikeda et al. discloses the application of AC potential to the working electrode is incorrect. As discussed above, what is applied to the working electrode is only a positive voltage, i.e., DC potential. In Example 7 of Ikeda et al., a potential of 500mV is applied to the third electrode and, after 2 seconds from the detection of

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sample supply, the potential is changed to -1300mV. However, both of "500mV" and "-1300mV" in this Example are DC potential. As would be recognized in the art, "potential" generally means DC unless there is a description of an AC potential having a central potential of 500mV. Although the Examiner alleged that "AC current can be either + or - while DC current is only positive ...," the Examiner has appeared to recognize that DC potential can be either + or -.

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Terra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Ikeda et al. does not anticipate claim 1, nor any claim dependent thereon.

It is further noted that claim 1 stands rejected, in part, under § 103 over Ikeda et al. and Kuwabata et al.. This rejection is respectfully traversed for reasons similar to those discussed above based on the deficiency of Ikeda et al., whose deficiency none of the cited prior art appear to obviate. As a preliminary matter, according to the construction of the Office Action, the Examiner relies exclusively on Ikeda et al. as allegedly disclosing AC, and relies on Kuwabata et al. only for an arbitrary AC range rather than AC itself (which would require strict compliance with the motivational requirement under § 103 for a specific modification).

In any event, Kuwabata et al. merely discloses that a sample includes ferrocene carboxylic acid and glucose oxidase each dissolved in phosphoric acid buffer, and glucose as a substrate is added thereto. However, the sample of Kuwabata et al. does not include a dissolved

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interfering substance contrary and is unrelated to such considerations when establishing the control parameters.

Indeed, Kuwabata et al. is completely silent about the specific effect which can be achieved by the present invention; namely, that a bad influence due to such an interfering substance can be reduced by the application of an AC potential to the working electrode such as an interfering substance. In this regard, as Kuwabata et al. is silent about such an interfering substance, it is respectfully submitted that even one skilled in the art can not achieve a "central potential (Ecen) and the most negative potential in a potential region where the reaction of said interfering substance at said working electrode is diffusion-controlled (Emin) satisfy the following equation: Ecen > Emin - 0.05(V)."

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In

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addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

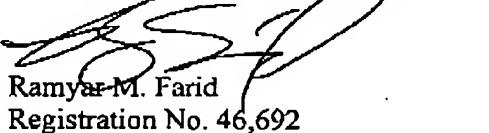
CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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